

REMARKS:

Claims 1-12 are in the case and presented for consideration.

The Office has objected to applicant's declaration that Fig. 1 shows "a conventional compact disc." Applicant has amended the specification to clarify that the compact disc in Fig. 1 is of a conventional circular shape. Applicant did not intend to mean that the compact disc of Fig. 1 was that of the prior art.

Claims 1-7 were rejected under 35 U.S.C §103(a) as being obvious from Japanese patent JP11-238262 to Otani et al. in view of Japanese patent JP2000-40263 to Inaba and U.S. Patent 5,791,990 to Schroeder et al.

Applicant respectfully traverses the rejection because several limitations of the claims are not taught or suggested by any of the cited references and the cited references are not combinable.

First, none of the references cited by the Office teach or suggest a compact disc having "at least one defined area with a border and central portion situated in the annular or recording portion containing a hidden printing," or "a scratch-off paint coating covering said defined area," as recited in claim 1. Since neither of the limitations are taught or suggested in any of the references cited by the Office, claim 1 cannot be obvious from any combination of the prior art.

Otani does not teach or suggest a compact disc having "at least one defined area with a border and central portion situated in the annular or recording portion containing a hidden printing," or "a scratch-off paint coating covering said defined area."

The Office states that Otani teaches a compact disc of circular shape having at least one defined area with a border and central portion situated in the annular or

recording portion containing a hidden printing (ABCDE in Fig. 1). However, Otani discloses a sandwich structure comprising a lower DVD-R disk substrate 11, a middle pressure sensitive adhesive sheet 41-1 having a pre-printed picture (designated ABCDE in the drawings) on its top surface, and an upper transparent disk substrate 12. The pre-printed picture cannot be construed as a hidden printing since the upper disk substrate 12 is transparent and lies completely over the adhesive sheet 41-1. Clearly, since the transparent disc substrate can be seen through, the printing (e.g, ABCDE) is not hidden. The printing is intended to be seen, as shown in Fig. 2B.

Applicant further notes that the coloring on the adhesive, which the Office defines as "a basic cover paint" is the only printing on the adhesive 41-1. In the Abstract, Otani states that "In order to provide the pictures on the sheet 41-1, adhesives are colored by pigments and dyes, for example, or colored adhesives are used." In other words, the picture ABCDE, for example, is colored onto an adhesive sheet 41-1. There is nothing else on the adhesive 41-1 to cover or hide the picture ABCDE. Since there is nothing to cover or hide the picture ABCDE, and a transparent disc substrate is affixed to the top of the adhesive sheet containing the picture ABCDE, the picture cannot be hidden. Therefore, the picture ABCDE cannot be construed as a hidden printing.

The Office further acknowledges on page 3 of the Office Action that Otani fails to show a scratch-off paint coating covering the defined area.

Like Otani, Inaba also does not teach or suggest a compact disc having "at least one defined area with a border and central portion situated in the annular or recording portion containing a hidden printing," or "a scratch-off paint coating covering said

defined area," as recited in claim 1.

As shown in the drawings in Inaba, the printing layer 4 is formed on the reflection film 5. There is nothing else on top of the printing layer 4. Therefore, the printing layer 4 is not hidden. No hidden printing is taught or suggested. Inaba also does not teach or suggest a scratch-off paint coating covering a defined area. The Office has not indicated otherwise.

Notably, the Office states on page 3 of the Office Action that:

"Inaba shows a compact disk wherein a reflective layer 5 provided on the recording portion of the disc body and covered by protective coating 3 (Fig. 3; and see Abstract)."

Applicant respectfully disagrees. First, Fig. 3 does not show a reflective layer 5. Although Fig. 1 shows a reflective layer 5, the reflective layer 5 is not provided on the recording portion. Nor is the reflective layer 5 covered by protective coating 3. On the contrary, the protective coating 3 is provided on the recording portion and covered by the reflective layer 5, as shown in Fig. 1 and described in the Abstract.

Like Otani and Inaba, Schroeder '990 also does not teach a compact disc having "at least one defined area with a border and central portion situated in the annular or recording portion containing a hidden printing," or "a scratch-off paint coating covering said defined area," as recited in claim 1. Nor does Schroeder '990 provide any suggestion to those skilled in the art to this end. Since neither of the limitations are taught or suggested in any of the references cited by the Office, claim 1 cannot be obvious from any combination of the prior art.

The Office states that Schroeder et al. shows a scratch-off paint coating to be used for compact discs. The Office refers to column 3, lines 24-25. The Office's

position is unsupported by the plain language of the specification. Column 3, lines 24-25 **do not** state that a scratch-off paint coating is used for compact discs. Schroeder '990 only states in col. 3, lines 22-25, that a package may be purchased that contains a ticket and a magnetic medium on which a computer program is stored. There is no indication that scratch-off coating is applied to the magnetic medium.

Although the Schroeder '990 patent indicates that either or both a ticket and magnetic media may contain an activation code (col. 5, lines 52-53), the description, examples, and claims only describe the use of the activation code with an opaque scratch-off coating in relation to the ticket. For example, the patent states in column 3, lines 32-35 that:

"In some embodiments of the invention, the player must remove the scratch-off coating on the ticket to reveal the activation code." [Emphasis added].

Schroeder '990 does not state anywhere in the patent that the scratch-off coating can be used with the activation code on the magnetic media.

Second, there is no suggestion or motivation to combine Schroeder '990 with either Otani or Inaba. Otani teaches a DVD-R which is an optical disc. Inaba also teaches an optical disc. In contrast, Schroeder '990 teaches magnetic medium. At col. 3, lines 23-25, Schroeder '990 discloses "a package containing a magnetic medium (e.g. a floppy or compact disc) and a ticket or card." At column 5, lines 37-38, the patent further states that "magnetic media contemplated by the present invention include so-called 'floppy' and 'compact' discs." Thus, the '990 patent has categorized these "compact" discs as **magnetic media**. Applicant also emphasizes that only the

word "compact" is in quotation marks, while the word "discs" is not. Thus, Schroeder '990 is most likely referring to magnetic discs that have a "compact" or small size.

Optical discs have nothing in common with magnetic discs. An optical CD is an optically readable medium with pits or differently reflecting spots on its surface arranged along tracks/grooves readable by a laser beam. Since optical discs are very different from magnetic medium, there is no suggestion or motivation to combine the magnetic media of Schroeder '990 with the optical discs of Otani and Inaba. Thus, the cited references are not combinable.

Third, claim 2 additionally recites at least one limitation not disclosed or suggested in any of the prior art references. None of the cited references teach or suggest "a translucent interlayer coating for protecting the hidden printing when applying and removing the scratch-off paint."

In the rejection of claim 2 on page 4 of the Office Action, the Office states:

"Inaba shows that the defined area printing is separated from the scratch-off paint by a translucent interlayer 41 for protecting the hidden printing when applying and removing the scratch-off paint."

Initially, applicant notes that Inaba does not disclose a translucent layer 41, as suggested by the Office. In fact, Inaba does not disclose any element with a reference number 41. Although Otani discloses an adhesive sheet 41-1, this sheet is printed with color. This sheet does not protect any hidden printing. The adhesive sheet 41-1 is not a "translucent interlayer for protecting the hidden printing when applying and removing scratch-of paint."

Next, Inaba does not teach or suggest "a translucent interlayer coating for protecting the hidden printing when applying and removing the scratch-off paint," as

recited in claim 2. Inaba discloses a protective coating 3 as a leveling or smoothing film which is disposed between the rough surface formed by grooves or pits 1a and the mirror finish surface reflection film 5. A printing layer 4 is formed on the mirror finished surface reflection film 5. As shown in the drawings in Inaba, there is nothing on top of the printing layer 4. There is no scratch-off coating on top of the printing layer 4. Inaba does not discuss scratch-off paint at all. Thus, the printing is not hidden. There is no translucent interlayer coating on top of the printing layer 4 either.

On page 3 of the Office Action, the Office states that Inaba discloses that the reflective layer 5 is covered by protective coating 3. Applicant respectfully disagrees. The protective film 3 is below the printing layer 4 and reflective film 5. The purpose of the protective film 3 is to ensure that "the mirror finished surface reflection film 5 does not receive the influence of the ruggedness of the pits 1a," so that the upper reflection surface 5 is level to enable easy printing thereon.

In short, Inaba does not teach or suggest a compact disc having a translucent interlayer coating for protecting hidden printing when applying and removing scratch-off paint, as recited in claim 2.

Fourth, none of the cited references teach or suggest an interlayer coating for protecting hidden printing that overlaps the border portion of the defined area by at least 2mm, as recited in claim 3. In fact, none of the references discuss any kind of overlap. The Office's rejection of claim 3 does not state any rationale based on a cited reference. Claim 3 depends from claim 2, and therefore is also patentable for the same reasons as claims 1 and 2.

Fifth, none of the cited references teach or suggest a compact disc "wherein the

thickness of the interlayer coating is in the range from 40 to 58 microns," as recited in claim 4. The Office construes the adhesive sheet 41-1 of Otani, having a thickness of 40-50 micrometers, as the claimed interlayer coating. The adhesive sheet 41-1 is a layer having a colored printed material on it. Adhesive sheet 41-1 is not a translucent layer for protecting hidden printing. Claim 4 depends from claim 3, and is therefore also patentable for the same reasons as claims 1-3.

Sixth, none of the cited references teach or suggest a compact disc wherein the scratch-off paint coating bears a guidance printing. Claim 5 depends from claim 1 and is also patentable for the same reasons as claim 1.

Seventh, independent claim 6 recites substantially the same elements and limitations as claim 1. Like claim 1, claim 6 recites a compact disc having "at least one defined area with a border and central portion situated in the annular or recording portion containing a hidden printing," which is not taught or suggested by any of the references. Independent claim 6 further recites a compact disc having "a scratch-off paint coating applied to said interlayer coating." None of the cited references teach or suggest a compact disc having a scratch-off paint coating applied to a translucent interlayer coating. Schroeder '990 only discloses a scratch-off coating for a ticket. Claim 6 is distinguishable from Schroeder '990 for the same reasons that claim 1 is distinguishable from Schroeder '990.

Eighth, claim 7 depends from claim 6 and is patentable for the same reasons as claim 6. Additionally, as explained above for the claim 3 rejection, none of the cited references teach or suggest a compact disc having a translucent interlayer coating that overlaps the border portion of the defined area of the compact disc by at least 2mm.

Also, none of the cited references teach or suggest a compact disc having a scratch-off paint coating applied to a translucent interlayer coating that is in the range of 40 to 58 microns in thickness.

Applicant has added new claims 8-12. New Independent claim 8 recites "a means for protecting the hidden printing when applying and removing the scratch-off paint." None of the cited references teach or suggest a means for protecting the hidden printing when applying and removing the scratch-off paint. As explained above, Inaba only discloses a leveling or smoothing protective film which is beneath the printed layer. Inaba does not disclose a means for protecting the hidden printing when applying and removing the scratch-off paint. Otani discloses a transparent disk that covers an adhesive sheet 41-1 with visible colored printing, but does not disclose a means for protecting any hidden printing.

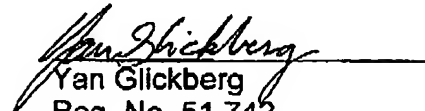
Claim 8 is also distinguishable from the cited references based on the arguments made above.

Accordingly, the application and claims are believed to be in condition for allowance, and favorable action is respectfully requested. No new matter has been added.

If any issues remain which may be resolved by telephonic communication, the Examiner is respectfully invited to contact the undersigned at the number below, if such will advance the application to allowance.

Favorable action is respectfully requested.

Respectfully submitted,


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